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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,638	12/27/2001	Youichi Hasegawa	111584	7760

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

COMAS, YAHVEH

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/026,638	HASEGAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yahveh Comas	2834	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1003</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 6/30/2003 have been fully considered but they are not persuasive.

In response to Ohya doesn't show a circumferential groove formed between the partition plate and the frame to connect the speed reduction chamber and the outside; Ohya disclose a groove formed between the top plate 12 and the frame 17, which connect the speed reduction chamber with the outside since the top plate 12 is part of the reduction chamber wherein the internal teeth ring gear is formed along the inner periphery of said top plate so that the top plate 12 is used as a ring gear member (column 3, lines 37-49 and fig. 1).

In response to Ohya doesn't show the portion plate 43 disposed between the motor case 44 and the frame 17 for forming a motor chamber and a speed reduction chamber; Ohya disclose the portion pate between the motor case 44 and the frame 17 (see fig. 1).

In response to Ohya doesn't show that top pate 12 doesn't correspond to a seal member disposed between the frame and the portion plate; Ohya disclose that the top plate 12 have a extension portion 52a to thereby prevent the water in the drain channel 51 from entering the inside of the starter through the joint (see fig. 3).

In response to applicant's argument that top pate 12 doesn't correspond to a seal member, disposed between the frame and the portion plate for preventing lubrication oil from leaking out from the speed reduction chamber, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to Ohya doesn't disclose the additional feature of the water drain pipe connected to the circumferential groove and integrated with the seal member; Ohya disclose that the drain channel 51 and the protruding wall 52 can be integrally formed in the frame 17 and the top plate 12 (see fig. 3)

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohya et al. U.S. Patent No. 5,844,336.

Ohya disclose a starter (1) for internal combustion engine comprising an armature having a armature shaft (4), a motor case (44) for accommodating said armature, a planetary gear speed reduction mechanism (2) connected to said armature shaft (4) at the end of said armature shaft (4). Also disclose a frame (17) coupled with the motor case (44) for covering the planetary gear speed reduction mechanism (2), and a partition plate (43) disposed between the motor case and the frame (17) for forming a motor chamber and a speed reduction chamber, wherein the

partition plate (43) has an armature shaft hole and a chamber connection passage between the armature shaft hole and the armature shaft for connecting the motor chamber and the speed reduction chamber, and a circumferential groove is formed between the partition plate that is part of the speed reduction chamber and the frame to connect the speed reduction chamber and the outside. Ohya disclose a seal member (12) and the use of a plurality of projection (52a) projects into the circumferential groove in combination with the seal member (12) to form a labyrinth and prevent the water in the drain channel (51) (column 6, line 5-20, see also fig 6).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 and 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohya et al. U.S. Patent No. 5,844,336 in view of Spellman et al. U.S. Patent No. 5,307,700.

Ohya, as applied in claim 1 above, disclose the claimed invention except for a through bolt for fastening the motor case to the frame wherein the circumferential groove opens outside at an outer vent disposed behind the through bolt. The frame has a cylindrical wall and a flange having a female screw for said trough bolt, and the outer vent is disposed behind the cylindrical wall. However, Spellman disclose the use of a through bolt for fastening the motor to the frame wherein the circumferential groove opens outside at an outer vent disposed behind the through

bolt. Also he disclose that the frame has a cylindrical wall and a flange having a female screw for said trough bolt, and the outer vent is disposed behind the cylindrical wall (see figure 1).

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modified Ohya 's invention and use a through bolt for fastening the motor to the frame in such way that the circumferential groove opens outside at an outer vent disposed behind the through bolt.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohya et al. U.S. Patent No. 5,844,336.

Ohya disclose the claimed invention except for an outer vent opened by drilling. However, Ohya discloses (column 6, lines 5-18) that if the outer vent is already part of the housing the manufacturing cost can be reduce. Also is already known in the art that by drilling you can make ventilation holes for the purpose of ventilation. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Ohya's invention and made the outer ventilation by drilling instead of making this ventilation hole part of the structure for the purpose of reduce manufacturing cost.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yahveh Comas whose telephone number is (703) 305-3419. The examiner can normally be reached on M - F 8:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

YC



Nicholas Ponomarenko  
Primary Examiner  
Technology Center 2800